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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|-------------------|
| 10/018,876 | 06/13/2002 | Andreas Hadler | DNAG 230 | 2623 |
| 24972 | 7590 | 11/18/2003 | EXAMINER | |
| FULBRIGHT & JAWORSKI, LLP 666 FIFTH AVE NEW YORK, NY 10103-3198 | | | | ALIMENTI, SUSAN C |
| ART UNIT | | PAPER NUMBER | | |
| | | 3644 | | |

DATE MAILED: 11/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/018,876 | HADLER ET AL. | |
| | Examiner | Art Unit | |
| | Susan C. Alimenti | 3644 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 08 September 2003.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 24-46 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 24-46 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) The translation of the foreign language provisional application has been received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

| | |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 28 recites the limitation "the tip angle" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 24-36, 41 and 46 are rejected under 35 U.S.C. 102(b) as being anticipated by Pejsa (US 4,776,279).

Pejsa discloses the claimed invention as best understood. Pesja's projectile 10 comprises a jacket 14, a nose 18, a soft core 12, and a hard penetrating core 30 disposed in front of the soft core 12. The nose 18 further comprises a conical recess, as viewed in Figure 2 with hard core 30 disposed therein, said conical recess having an acute tip angle between 30-90 degrees and a cavity 32 that extends no more than $\frac{3}{4}$ of the length of the projectile. The recess is surrounded by a circular annular surface created by jacket 14 at the fore-end of the projectile. Regarding claim 35 the embodiment as viewed in Figure 3 comprises a nose with a flat head. Regarding claim 41, the projectile 10 also has a sharp edge 40 (See Examiner's reference character in

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Figure 1). Finally with regard to claim 46, Pejsa discloses that the hard core 30 may be made of a plastic material (Pejsa, col.4, lns.40-48), and several other materials are mentioned in the construction of the projectile such as brass (Pejsa, col.3, lns.57).

5. Claims 24-27 and 31-39 are rejected under 35 U.S.C. 102(b) as being anticipated by Behr et al. (DE 191 181 C).

Behr et al. (Behr hereafter) discloses a projectile as cited in claims 24 and 36-39. Behr's projectile comprises a soft core *a* with a recess, a hard core *b*, disposed inside the recess in front of the soft core *a*, and a cap or tip *d* placed inside the hard core *b*. The tip *d* further comprises a shaft *c*, which extends into hard core *b*.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Behr as applied to claims 24, 36 and 38 above, and further in view of Pejsa.

Behr discloses the claimed invention, as best understood, except it is not clear what the tip is made of. Pejsa discloses a projectile in the same field of endeavor, that being expanding or fragmenting projectiles, that teaches using a plastic material to construct the hard penetrating core and tip 30. It would have been obvious to one having ordinary skill in the art at the time the

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invention was made to make the Behr's tip out of a plastic material, since it has been held to be within the general skill of a worker in the art to select a known material based upon its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

8. Claims 41 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pejsa as applied to claim 24 above, and further in view of Lumalampan (GB 592 538 A).

Pejsa discloses the claimed invention, as best understood, except there is not sharp edge formed by a crimping in the jacket. Lumalampan discloses a projectile with a sharp edge 4 created by a crimping in the jacket of the projectile, said sharp edge 4 being located at a transition point between a hard penetrating core 2 and a soft inner core 5 (Lumalampan, Figure 1). Lumalampan teaches that the sharp edge 4 is to allow for the projectile to be fixed into a casing (Lumalampan, pg.2, lns.36-40). It would have been obvious to one having ordinary skill in the art at the time the invention was made to create a crimped edge in order to facilitate securing the projectile inside a casing shell.

9. Claims 43 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pejsa and Behr as applied to claim 24 above, and further in view of Giannoni (US 6,148,731).

Pejsa and Behr disclose the claimed invention, as best understood, except the wall thickness is not disclosed to change. Giannoni discloses a projectile in the same field of endeavor, that being expansion projectiles, that teaches the use of a decreasing jacket wall thickness in order to provide more support for the base of the projectile upon impact. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the thickness of the walls to decrease toward the front of the projectile to affect dispersion of the contents upon impact.

10. Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pejsa and Behr as applied to claim 24 above, and further in view of Winter (US 6,148,731).

Pejsa and Behr disclose the claimed invention, as best understood, except the use of lead free materials in the manufacture of the projectile is not positively stated. Winter discloses an expansion projectile that is made from lead-free materials. Winter explains that a lead core tends to splinter upon impact causing undesired contamination for instance in hunting applications, and the use of non-lead materials could avoid such a situation (Winter, col.1, lns.19-35). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use non-lead materials when making expanding bullets in order to avoid contamination of lead into the area surrounding the intended target and the target itself.

Response to Arguments

11. Applicant's arguments filed 8 September 2003 have been fully considered but they are not persuasive. The crux of applicant's arguments is that the projectiles disclosed by Pejsa and Behr do not anticipate the claimed invention because upon impact the projectile core "does not separate from the bullet and does not exit from the target body" (Arguments, p.6, ¶ 1). A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, applicant is reminded that both aforementioned references, as applied, anticipate the structural limitations set forth in claims 24-46, and if

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applicant wishes for further limitations to define the present invention, such limitations should be amended to the claims.

In response to the argument that Behr and Pesja are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, both patents disclose expanding or fragmenting projectiles and are therefore considered to be analogous art.

In conclusion the examiner maintains the rejections of claims 24-46.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan C. Alimenti whose telephone number is 703-306-0360. The examiner can normally be reached on Monday-Friday, 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles T. Jordan can be reached on 703-306-4159. The fax phone number for the organization where this application or proceeding is assigned is 703-305-7687.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

SCA

Charles T. Jordan
CHARLES T. JORDAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600